

REMARKS/ARGUMENTS

Claims 1 through 16, all the claims of the application, remain rejected under 35 USC Section 103(a) as being unpatentable over (i) U.S. Patent No. 6,063,741 to Naitoh et al. (hereinafter the "Naitoh et al. '741 patent"), in combination with either U.S. Patent No. 6,139,022 to Iwashita et al. (hereinafter the "Iwashita et al. '922 patent") or U.S. Patent No. 6,325,385 to Iwashita et al. (hereinafter the "Iwashita et al. '385 patent"). The claims were further rejected under 35 USC Section 103(a) as being unpatentable over U.S. Patent No. 6,444,624 to Walker et al. (hereinafter the "Walker et al. patent") in view of U.S. Patent No. 6,893,720 to Nakahigashi et al. (hereinafter the "Nakahigashi et al. patent"). The Naitoh et al. patent and Walker et al. patent were individually cited as teaching lubricating oil compositions containing, *inter alia*, molybdenum compounds. Each of the Iwashita et al. '922 patent, the Iwashita et al. '385 patent and the Nakahigashi et al. patent was cited for teaching objects, such as engine parts, coated with a diamond-like carbon film. It is alleged that, as the Naitoh et al. patent and Walker et al. patent teach that certain lubricants containing molybdenum compounds provide advantages in "engines", it would obvious to use such compositions to lubricate parts having diamond-like carbon (DLC) coatings because the term "engines" does not exclude engines having DLC coated parts.

Applicants respectfully traverse these grounds for rejection.

Applicants filed comments on the above grounds for rejection, and provided certain supporting data in their response dated November 2, 2007, and said comments were reiterated in a response filed July 8, 2008, all of which applicants incorporate into the present response, by reference. In the present Office Action, it is recognized that the data previously submitted demonstrates that, for steel on steel lubrication, "friction modifiers" historically used in lubricating oil compositions all reduced friction, but that with DLC coated surfaces, certain friction modifiers have no significant effect on friction, while molybdenum compounds do. This result was considered insufficient to address a case of *prima facie* obviousness on the basis that not all friction modifiers would be expected to provide identical friction reducing performance. However, the data does not demonstrate that there is a difference in the degree of friction modification between the inventive and comparative materials; it demonstrates that the inventive friction modifier providing excellent friction reducing properties with DLC coated surfaces while the comparative material, which one of ordinary skill in the art would expect to have similar effect, was shown not to have any significant friction modifying ability.

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Applicants submit that the data previously provided demonstrates an unexpected synergy between the molybdenum compound of the claimed lubricant, and the DLC coating of the claimed engine part being lubricated. It is further submitted that this situation is no different from one in which an inventor combines two individually known components and finds that the combination provides an unexpectedly improved result compared to when combinations of what are thought to be substantially similar materials (from a performance standpoint) are employed. It is well settled that a demonstration of unexpected improved results is strong evidence of non-obviousness and, as neither the primary references describing lubricating oil compositions containing molybdenum compounds, nor the secondary references describing parts coated with DLC surfaces suggest any benefit of the specific combination now claimed, Applicants submit that the improved results shown must be considered surprising and unexpected, and that the rejections presented under 35 USC Section 103(a) should be withdrawn in view of same.

Based upon the foregoing, applicants submit that the invention as claimed is distinguishable over the cited combination of prior art references. Applicants therefore respectfully request that all grounds for rejection presented under 35 USC Section 103(a) be withdrawn and the application now be passed to issue.

Respectfully submitted,



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